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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,851	08/30/2001	Kevin P. Baker	P2548P1C7	2329

7590

09/09/2003

BRINKS HOFER GILSON & LIONE  
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CHICAGO, IL 60611-5599

EXAMINER

O HARA, EILEEN B

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/943,851

Applicant(s)

BAKER ET AL.

Examin r

Eileen O'Hara

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 22-27 are pending in the instant application. Claims 1-21 have been canceled as requested by Applicant in Preliminary Amendment C, Paper Number 3, filed August 30, 2001.

All claims are currently under examination.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Specifically, the Address of inventor Dan L. Eaton was changed, and the change was neither initialed nor dated.

### ***Information Disclosure Statement***

- 3.1 The IDS has been considered by the examiner, however, the information will not be published.
- 3.2 Applicants are advised that the IDS had Ashkenazi et al., and not Baker et al., as inventors.

### ***Specification***

- 4.1 The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. For example, embedded hyperlinks are found on page 25, line 10, page 27, line 31, page 94, line 32 and page 96, line 13.

Appropriate correction is required.

4.2 The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Antibodies to PRO344 protein.

4.3 The abstract of the disclosure is objected to because it does not specifically recite the claimed invention. Correction is required. See MPEP § 608.01(b).

#### ***Claim Objections***

5. Claim 25 is objected to because of the following informalities: as written it is grammatically incorrect. It is suggested the claim be re-written as follows:

“A fragment of the antibody of claim 22, wherein the fragment binds the polypeptide of SEQ ID NO: 42.”

Appropriate correction is required.

#### ***Advisory Information***

6. Claim 25 is interpreted such that the fragment of the antibody must also bind the protein. If Applicants intend otherwise, it is suggested the claims be amended to clarify this.

#### ***Double Patenting***

7. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims

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from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

A sequence search of the pending and published application databases has revealed that there are a series of applications in which SEQ ID NO: 42 is present but that do not claim the antibodies to the polypeptide. However, there are numerous other applications filed by the applicants which contain the polypeptide of SEQ ID NO: 362 which is identical to the polypeptide of SEQ ID NO: 42, and which may contain possible conflicting claims. Due to the large number of applications that contain this sequence, the examiner is unable to determine if any of these applications have claims directed to antibodies to this polypeptide. Applicant is required to point out to the Examiner all double patenting issues. See MPEP § 1.105.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 22-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Sheppard et al., US Patent No. 6,197,930, issue date March 6, 2001, effective priority date August 26, 1997. The effective priority date of the instant application is December 16, 1997 (60/069,694).

Claims 22-27 encompass antibody that binds to the polypeptide of SEQ ID NO: 42, wherein the antibody may be a monoclonal antibody, a humanized antibody, an antibody fragment, or labeled. Sheppard et al. disclose a protein (zsig39, SEQ ID NO: 2) that is identical to the polypeptide of SEQ ID NO: 42 of the instant application (see attached sequence alignment). Sheppard et al. also teach monoclonal, humanized and antibody fragments to the protein (column 35, lines 6-29), and antibody which is labeled (column 20, lines 53-65, column 36, line 47 to column 37, line 21).

Therefore, Sheppard et al. anticipates the claims.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 22 and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 is directed to an antibody that binds to the polypeptide of SEQ ID NO: 50, and such an antibody could exist in nature. The rejection would be withdrawn if the word “isolated” were inserted in front of “antibody” (specification, page 33, lines 11-20).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 22-27 are indefinite because claim 22 encompasses an antibody that binds to a polypeptide of SEQ ID NO: 42, and claim 27 encompasses an antibody that “specifically binds”. The specification does not define the term “specifically binds” and it is not clear what this means, and it is not clear what the difference in scope between “binds” and “specifically binds” is. The other claims are rejected for depending from claim 22.

***Conclusion***

11. No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

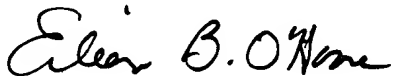
Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

A handwritten signature in cursive script that reads "Eileen B. O'Hara".

Patent Examiner